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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,279	03/06/2002	Thomas Martin	24903	4653

34375 7590 11/19/2003

NATH & ASSOCIATES PLLC
1030 FIFTEENTH STREET, N.W.
SIXTH FLOOR
WASHINGTON, DC 20005

EXAMINER

TUCKER, ZACHARY C

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/19/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,279

Applicant(s)

MARTIN, THOMAS

Examiner

Zachary C. Tucker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Response to Amendment

Claims 9 and 10 have been amended, as requested in the response dated 28 October 2003; to the Office action dated 06 October 2003.

Election/Restrictions

The Office action dated 06 October 2003 set forth a requirement for an election of species.

Applicant's traversal of what was understood to be a restriction requirement is acknowledged. However, as the instant case was filed under 35 U.S.C. 371, being the U.S. national stage of PCT/EP00/08899, Markush practice is not changed in a 371 application.

Searching all of claim 1 would be a serious burden on the examiner. It should be abundantly clear because *innumerable* of compounds are embraced by claim 1. A complete search of claim 1 in one application (without filing divisional applications) would require at least scores of hours of examining time, the filing fees paid thus far not even coming close to paying for the examiner's efforts.

The examiner may require the election of a single disclosed species whether the application is filed under 35 U.S.C. 111 or 371.

The MPEP, in chapter 1850, section "D" sets forth Markush practice in the context of the PCT rules. Applicants have chosen to file the instant application under 35 U.S.C. 371, and thus have chosen to abide by PCT rules as they relate to Markush practice, which state:

D. "Markush Practice"

The situation involving the so-called Markush practice wherein a single claim defines alternatives (chemical or non-chemical) is also governed by PCT Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in PCT Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

- (A) All alternatives have a common property or activity, and
- (B)
- (1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or
- (C)
- (2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

In paragraph (B)(1), above, the words "significant structural element is shared by

all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

As the claimed compounds are allegedly novel, applicants would certainly agree that point (C) does not apply in the instant case, as the claimed compounds could not be art-recognized if they are novel.

Therefore, requirement for an election of species is proper in view of the fact that while the claimed compounds might share a common property (this may or may not be true – applicants are being given the benefit of the doubt), compounds according to claim 1 do not possess a common structure – for at least the reasons that 6 distinct cores are specified in claim 1, and also because 5 distinct ring identities for A3 and A4 are possible (in addition to the acyclic alternatives for A3 and A4).

Additionally, in view of the multitudinous permitted identities for the B1, B2, A1, A2, B3, B4, A3, A4, B5, B6, A5, A6, K1, K2, X1, X2, Y1, Y2, Z1 and Z2, to suggest that

every compound of claim 1 possesses a common structure would fly in the face of reason.

The election of 1,3-*bis*-(4-aminomethylbenzylaminocarbonylmethyl-1-oxyprop-2-ynyl)-benzene, which applicant state is readable on claims 1-4 and 6-8 is noted.

Claims 5, 9 and 10 therefore stand withdrawn with traverse, as not readable on the elected species.

Misjoinder of Invention

Claim 1 constitutes an improper joinder of inventions as it groups together species that are distinct and separately classified, and will support separate patents. *Ex parte* Markush, 1925 C.D. 126, provided for this claim structure where there was an emergency engendered need, as the substances were "so closely related that they would not support a series of patents." This is not true for instant claim 1. Therefore, the instant generic claim constitute an improper joinder of inventions; *Ex parte* Reid, 105 U.S.P.Q. 251; *In re* Winnek, 73 U.S.P.Q. 225; *In re* Ruzicka, 66 U.S.P.Q. 226.

37 C.F.R. 1.104

(b) Completeness of Examiner's Action.

The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) Rejection of claims.

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(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims or those considered unpatentable will be rejected.

Thus, claim 1 is rejected because it is not deemed patentable by the Office at this time. Claims 2-4 and 6-8, which depend from claim 1 are also rejected because they depend from a rejected claim.

Applicant need provide a searchable genus, from the elected species.

Conclusion

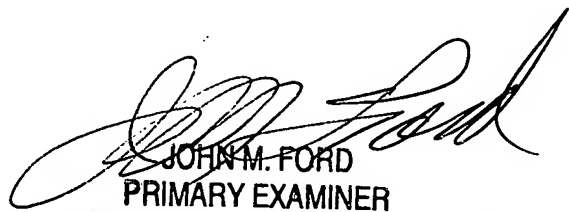
Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (703) 305-2050. The examiner can normally be reached Monday-Friday from 7:00am to 3:30pm. If Attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mukund Shah, can be reached at (703) 308-4716. The fax number for the organization where this application or proceeding is assigned is (703) 308-4556 for regular communications and (703) 308-4242 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT

